

608.04(a) Matter Not in Original Specification, Claims, or Drawings

Matter not in the original specification, claims, or drawings is usually new matter. Depending on circumstances such as the adequacy of the original disclosure, the addition of inherent characteristics such as chemical or physical properties, a new structural formula or a new use may be new matter. See *Ex parte Vander Wal*, 109 USPQ 119, 1956 C.D. 11, 705 O.G. 5 (Bd. App. 1955) (physical properties), *Ex parte Fox*, 128 USPQ 157, 1960 C.D. 28, 761 O.G. 906 (Bd. App. 1957) (new formula) and *Ex parte Ayers*, 108 USPQ 444 (Bd. App. 1955) (new use). For rejection of claim involving new matter, see MPEP § 706.03(o).

For completeness of disclosure, see MPEP § 608.01(p). For trademarks and tradenames, see MPEP § 608.01(v).

608.04(b) New Matter by Preliminary Amendment

An amendment is sometimes filed along with the filing of the application. Such amendment does not enjoy the status as part of the original disclosure in an application filed under 37 CFR 1.53(b) accompanied by a signed oath or declaration unless it is referred to in the oath or declaration filed therewith. Once an oath or declaration is submitted in an application filed under 37 CFR 1.53(b) identifying the papers which the inventor(s) has “reviewed and understands” as required by 37 CFR 1.63, the original disclosure of the application is defined and cannot be altered merely by filing of a subsequent oath or declaration referring to different papers. Where a 37 CFR 1.53(b) application is filed without a signed oath or declaration and such application is accompanied by an amendment, that amendment is considered a part of the original